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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
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Name _____

Application Number:

10/575,275

Filed: April 11, 2006

First Named Inventor:

Hasse SINIVAARA

Art Unit: 2618

Examiner: Amar A. Daglawi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

/Alicia M. Choi/

Signature



Applicant/Inventor.



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under

Alicia M. Choi

37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

Typed or printed name



Attorney or agent of record.

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Attorney or agent acting under 37 CFR 1.34.

Registration Number if acting under 37 CFR 1.34 February 9, 2010

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 7231

Hasse SINIVAARA

Art Unit: 2618

Application No.: 10/575,275

Examiner: Amar A. Daglawi

Filed: April 11, 2006

Attorney Dkt. No.: 060091.00457

For: SERVICE DISCOVERY IN A WIRELESS COMMUNICATION SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 9, 2010

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicant hereby submits this Pre-Appeal Brief Request for Review of the final rejections of claims 1-20, 23-25 and 27-32 in the above identified application. Claims 1-20, 23-25 and 27-32 were finally rejected in the Office Action dated November 9, 2009 ("Office Action"). Applicant hereby appeals these rejections and submits this Pre-Appeal Brief Request for Review. A Notice of Appeal is timely filed concurrently herewith.

Clear Error: Rejection Fails to note "receiving, from a mobile network, an indication at a multimode terminal operably connected to the mobile network..." Feature

Karaoguz discloses systems and methods for implementing multi-mode wireless communication devices such as PDAs or multi-function mobile phones that take advantage of the wireless networks in their proximity. In the case where a nearby wireless network happens to provide more data bandwidth and/or better quality of service, a multi-mode wireless device may switch to that particular wireless network to access these services. A multi-mode controller in the device may be used to alternately

poll different networks to determine whether the device is within the area of coverage of a network and to selectively establish communications with those networks.

Applicants respectfully submit that Karaoguz fails to disclose or suggest all of the elements of the present claims. For example, Karaoguz does not disclose or suggest, at least, “receiving, ***from a mobile network***, an indication at a multimode terminal operably connected to the mobile network, the indication indicating that services may be locally available via at least one short-range wireless network,” emphasis added, as recited in claim 1. Similarly, Karaoguz fails to disclose or suggest “a receiver configured to receive an indication, ***from the mobile network***, through the first radio interface, the indication indicating that services may be locally available for the multimode terminal via at least one short-range wireless network,” emphasis added, as recited in claim 27 and similarly recited in claim 32.

In response, the Office Action indicated that FIG. 4 of Karaoguz describes a multi-mode controller #80 which is part of the mobile device. However, the Office Action appears to have erroneously overlooked that the multi-mode controller 80 detects the availability of short range networks itself, as opposed to receiving such indication from the mobile network.

Karaoguz fails to disclose or suggest receiving any indication from the mobile network indicating that services may be available via a short-range wireless network. Although Karaoguz discloses that a “multimode controller 80 receives network information 88 indicative of whether the device is within range of a supported network” (Karaoguz, paragraph 0044), Karaoguz does not disclose that this network information is received from the mobile network. Rather, it appears that, according to Karaoguz, the device itself informs the multimode controller of whether the device is within range of a supported network. In other words, according to Karaoguz, the network information is provided by the device, not by the mobile network. In particular, paragraph 0035 of Karaoguz provides that “*each multi-mode communication device 30 or 34 determines whether it is within the area of coverage of a type of network that is supported by the*

multi-mode communication device” (Emphasis added) (Karaoguz, paragraph [0035]). Nowhere does Karaoguz disclose receiving an indication indicating that services may be available via a short-range wireless network **from the mobile network**. (Emphasis added) Fig. 4 of Karaoguz, and the corresponding sections of the description (paragraphs [0044]-[0050]), does not disclose that the “network information” is received from an outside source, such as the mobile network.

Upon review of the Office Action, it appears that the Office Action did not address this particular argument presented in the Response filed on June 23, 2009, which Applicant respectfully submits is clear error. The Applicant referred to specific portions of Karaoguz to clearly show that the device, not the mobile network, that services may be available via a short-range wireless network. The failure to recognize such deficiencies of Karaoguz is clear error.

Fig. 14 of Karaoguz discloses explicitly how the presence or absence of short-range networks (Bluetooth or 802.11) is detected, and the result of such detection is the “network information 88” shown in Figure 4. In connection with Figure 14, Karaoguz discloses that the detection of short-range networks (Blue-tooth or 802.11) is initiated in step 232: “In the absence of any network connection, the dual-mode controller initiates a new network scan request 232 every ‘CFP Maximum Duration’ per 802.11b MAC specification” (Karaoguz, paragraph 0086). Because the “dual-mode controller,” which is an embodiment of the “multi-mode controller,” resides in the communication device (terminal), *it is the terminal and not the mobile network that initiates the detection of short-range networks*. (Emphasis added) Nevertheless, once again, it does not appear that the Office Action addressed this particular argument presented in the Response filed on June 23, 2009, which Applicant respectfully submits is clear error.

Therefore, for at least the reasons outlined above, Karaoguz does not disclose or suggest, at least, “receiving, from a mobile network, an indication at a multimode terminal operably connected to the mobile network, the indication indicating that services may be locally available via at least one short-range wireless network,” as recited in

claim 1. Similarly, Karaoguz fails to disclose or suggest “a receiver configured to receive an indication, from the mobile network, through the first radio interface, the indication indicating that services may be locally available for the multimode terminal via at least one short-range wireless network,” as recited in claim 27 and similarly recited in claim 32. Thus, this portion of the rejection is in clear error.

Additionally, Karaoguz fails to disclose or suggest, “wherein *the indication received from the mobile network* includes instructive information for the collecting of said service information,” emphasis added, as recited in claim 7. As discussed above, Karaoguz does not disclose an indication received from the mobile network. Karaoguz similarly fails to disclose or suggest a network address extracted from the indication. It is evident that the features of claim 7 further support that the multimode terminal first receives “the indication received from the mobile network” and the indication instructs the multimode terminal to collect the service information. Karaoguz, instead, describes a system where the multimode controller of the device collects the network availability information itself, that is, spontaneously, without any instruction received from the mobile network. Therefore, Karaoguz fails to disclose or suggest the limitations of claim 7.

Karaoguz also fails to disclose or suggest, “wherein the presenting comprises presenting a required connectivity standard for each of the at least one service,” as recited in claim 16; and “wherein the service list comprises service providers corresponding to the at least one service,” as recited in claim 17. Karaoguz is silent regarding the presentation of a required connectivity standard, and also does not mention a service list comprising service providers.

Further, Karaoguz does not disclose or suggest, “receiving the indication as part of system information sent from the mobile network,” as recited in claim 19. As discussed above, Karaoguz fails to disclose receiving an indication from the mobile network and, therefore, also fails to disclose receiving the indication as part of system information sent from the mobile network.

For at least the reasons discussed above, Applicants respectfully submit that Karaoguz fails to disclose or suggest all of the features of independent claims 1, 27, and 32. Accordingly, Applicants respectfully request that the rejection of claims 1, 27, and 32 be withdrawn.

Claims 2-20 depend from, and further limit, independent claim 1, and claims 23-25 and 28-31 depend from, and further limit, independent claim 27. Thus, each of claims 2-20, 23-25, and 28-31 recites subject matter that is neither disclosed nor suggested in Karaoguz. It is, therefore, respectfully requested that the rejections of claims 2-20, 23-25, and 28-31 be withdrawn.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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Enclosures: PTO/SB/33 Form
Notice of Appeal